

REMARKS

Status of the Claims

Claims 1, 6, 8-12 have been rejected as being drawn to an improper Markush Group.

Claims 1-2, 6, and 8-12 have been rejected under 35 U.S.C. 112, second paragraph.

Claims 1-2, 6 and 8-12 have been rejected under 35 U.S.C. 112, first paragraph.

The specification has been rejected for the introduction of new matter.

Interview Summary and Amendments

Applicants appreciate the informative telephonic interview with the Examiner conducted October 28, 2005. In addition to the Examiner and the undersigned, John Somerville and Ashok Purandare participated in the interview.

The morning of the interview the Examiner was faxed a discussion of references which had been previously been submitted to the Examiner as a basis for what was known by one of skill in the art about CCR4 antagonism. The references referred to in the fax will be formerly re-submitted in an IDS. The nature of the information that the references must contain in order to be enabling for claims that recite the treatment of disease (claims 8-12 of the present application) was discussed. However, no agreement was reached with respect to the enablement of claims 8-12. In order to expedite the issuance of this application, method-of-use claims 8-12 have been canceled. Applicants reserve the right to pursue the canceled claims and other unclaimed matter in a continuing or divisional application. Accordingly, in order to expedite the issuance of this application, method-of-use claims 8-12 have been canceled in this amendment. Applicants reserve the right to pursue the canceled claims and other unclaimed subject matter in a continuing or divisional application.

Also discussed in the interview was the rejection of the specification under 35 USC 132(a) for the introduction of the term "IC50" added by amendment to label the data presented on page 48. In the last amendment Applicants asserted that the introduction of this term does not represent new matter as one of skill in the art would understand that data reported from native (whole) cell assay are IC50 values. In the interview Applicants explained that Ki values are generally not calculated for whole cell assays (using the Chang-Prushoff equation) since such calculations rely on a static receptor density or concentration. In live whole cells, the receptor density can vary significantly from assay to assay, and the receptors are often internalized upon ligand binding and recycled. Accordingly, an IC50 is the commonly reported value for such cell based assays and data generated from such assays would be understood as such. Applicants respectfully request the withdrawal of the new matter rejection under 35 USC 132(a).

Finally, the rejection of compound/composition claims 1, 2, 5 and 6 under 35 U.S.C. 112, second paragraph was discussed in the interview. The Examiner had rejected the term "including" in claim 1 of variable G as being open-ended and suggested the term "can be". In discussion, Applicants agreed to amend the G definition to delete the term "includes" and replace it by "can also be", which has been done by amendment of claim 1 herein. In addition, Applicants pointed out that the variable "n" is still present in claims 1 and 2, and accordingly the use of the variable "n" in claims is not indefinite. The Examiner conceded and withdrew the rejection. Applicants respectfully request withdrawal of the rejection of the claims under

The Examiner also rejected the revised definition of Z as raising new matter, contending that the original scope of the application does not include a 1,2 propylene group in the G variable. In response, Applicants noted that the original definition of Z included alkylene (1,2-propylene is within the scope of alkylene) in the F variable, and that the variables F and G had been interchangeable in the original application. Accordingly, the original scope of the application included the possibility of an alkylene linker group in Z, even though the current amended definition of Z no longer includes the variable F. The Examiner understood and agreed that if the variable G included the term "alkylene", that the definition of Z would no longer constitute new matter. Accordingly, claim 1 has been amended to specify that where Z is $C(=O)GR^2$, G can also include alkylene. Applicants respectfully request withdrawal of the new matter rejection and assert that the claim 5 is not indefinite as claim 1 provides scope for the last claim 5 species.

Election/Restrictions

Claims 1,6, and 8-12 were also rejected as being drawn to an improper Markush Group. In response, Applicants have followed the Examiner's suggestion and canceled the non-elected subject matter by setting $X=Y=N$ and requiring that exactly one of A, B,D, and E is N. Applicants believe the amended claims read only on the elected group and Applicants request withdrawal of the rejection for an improper Markush Group.

Applicants believe the amendments discussed above add no new matter, nor broaden the scope of the amendments over the scope of the claims as filed.

Summary


Applicants believe the presently amended claims are now in condition for allowance. The Examiner is invited to contact the undersigned by telephone, at the number listed below, if it is believed that a telephonic communication would facilitate the prosecution of this application.

Fees

No additional fees should be due, aside from the fee due for the two-month extension of time. However, if it is determined that an additional fee is due, please charge same to Deposit Account No. 19-3880 in the name of Bristol-Myers Squibb Company.

Respectfully submitted,

Bristol-Myers Squibb Company
Patent Department
P.O. Box 4000
Princeton, NJ 08543-4000
609-252-5323


Laurelee A. Duncan.
Attorney for Applicants
Reg. No. 44,096

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